

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Russell E. Parks et al.

Serial No. 09/759,016

Group Art Unit 3629

Filed January 12, 2001

Examiner Jonathan P. Ouellette

For SKILLS MATCHING APPLICATION

Assistant Commissioner for Patents
Washington, D.C. 20231

DECLARATION OF RUSSELL E. PARKS
UNDER 37 C.F.R. §1.132

Russell E. Parks declares as follows:

1. I am one of the named inventors in the above-identified patent application.
2. Briefly described, the invention disclosed therein relates to a Skills Matching Application or SMA application or tool. The SMA application is a tool that allows a user, such as a hiring manager, to communicate requirements to technical service suppliers in a way that significantly reduces the process time and improves the accuracy of requests sent to suppliers. While methods have been developed to procure components and hardware in manufacturing many products, including for example automobiles and computers, the procurement of services, and especially technical services, has not received the same attention. Prior to the present invention, the process was still a matter of advertising, using third party employment services and other intermediaries. The SMA application provides a way to timely respond to a specific, immediate although temporary need for technical services.

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3. I have read and understand the Office Action mailed November 25, 2002. The Examiner has rejected claims 1 to 7, all the claims in the patent application, under 35 U.S.C. §101 and 35 U.S.C. §112, first paragraph, as lacking utility and, therefore, not being usable by one of ordinary skill in the art. In addition, the Examiner has rejected claims 1 to 7 under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,289,340 B1 to Puram et al.

4. As to the rejections of the claims under 35 U.S.C. §101 and 35 U.S.C. §112, first paragraph, as lacking utility, the Examiner is in error. The SMA application has experienced significant increase in usage within the IBM Corporation in the past three years. The following table shows the increase in activity

	Activity 1999/2000	Activity 2002	Comments
Requests Created	First Half 2000 – 78 requests	Full year 2002 – 23651 requests	
Handsfree Requests Created	Full Year 2000 – 1940 requests	Full Year 2002 – 9876 Requests	These are requests that go through the entire process without buyer intervention
User IDs Created	Full Year 2000 – 500	Full Year 2002 – 4505	
Dollars through system	Half year 2000 – Approx. \$5M	Full Year 2002 – \$1.76B	

The Skills Matching Application was modified in 2002 to accommodate the buying of other service commodities within the IBM Corporation. The Complimentary Workforce Commodity and the Business Services Commodity were added to the SMA tool now making the SMA application the single means to purchase all services in the IBM Corporation. Quite clearly, the SMA application has demonstrated considerable commercial success which, in turn, is a demonstrative indicator of the utility of the invention.

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In making his rejection, the Examiner stated that "In Claims 1-7, the ambiguities cited would make it impossible for the process to be repeatable or 'concrete'. In other words, different users would come up with different responses." In response, since different individuals have different skill sets and different requesters have different skill needs, one would expect different users to come up with different responses. Moreover, this should not be taken as an indication that the process is not repeatable or concrete.

The SMA tool is designed to buy services versus products. The response to each request will be the resume of a different person. But by design, the Job Descriptions within the SMA application for that skill type are defined to describe very specific Type of Skills. For example, we have a Skill Type "Programmer" which is supported by a specific job description. Then within that "Programmer" job description, there are several levels of expertise. When a requester needs to hire a "Programmer", the requester selects the specific job description, then defines the customizable attributes of that programmer. A good analogy is buying a car. You go shopping for a Ford Mustang Convertible, then you customize the color, engine, etc. The process is very much repeatable as you are limited to buying the Skill Types defined to the SMA application.

5. I have read and understand the Puram et al. reference relied on by the Examiner and I have reviewed the several other references cited by the Examiner. I note first of all that the many references cited by the Examiner, including the Puram et al. reference, seem to demonstrate rather conclusively that the claimed invention has utility under the Patent Statute. Considering the cited prior art, the SAM application of the claimed invention differs from all other applications of this type in that it supports the end-to-end process of buying services. Considering the Puram et al. reference specifically, the reference describes what is known in the art as a "Monster Board" where technical services providers enter data about their skills and users of these skills enter requirements and the system attempts to make a match. Skills matching as claimed in this patent application differs in that first it

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is a proprietary system. IBM Corporation has core suppliers of services that are allowed to receive requirements from the SMA tool. The SMA tool has pre-negotiated cap rates and job skills defined to the system. The suppliers are responding to the Request for Service (RFS), and in most cases supply that service at or below the negotiated price. If a supplier responds above a negotiated rate, the SMA tool notifies the IBM buyers of the service. The SMA tool then creates a means for the requester and supplier to interact on the RFS. When a candidate is finally chosen, the SMA application creates the appropriate data transaction to create an IBM Purchase Requisition within the IBM Requisition Tool Request Category. This process is facilitated in that the SMA tool will designate the rate as a BUYERLESS transaction and, once management and financial approvals are provided, the Purchase Order is transmitted.

In contrast, Puram et al. is a system that includes a database of perspective candidates. The candidate information is entered into the system, and then a requester enters their requirements and the application does a comparison of candidate attributes to requirements. I would also assume that the Puram et al. application is for not only temporary, but more likely permanent placement of the technical resource. The SMA tool is not a database and is strictly a procurement tool for the acquisition of temporary resources. It is a communication tool to a predefined list of IBM Technical Services suppliers. The suppliers review the IBM requirements based on a pre-approved IBM job description. The pricing, T&Cs, quality level and other IBM conditions are assumed when you are allowed to access the SMA application. Suppliers then respond to the requirement with candidate(s). Selection is then by the IBM requester. Once a candidate is selected, the SMA tool closes the purchasing loop and creates a Purchase Requisition.

6. I have reviewed each of the other references cited by the Examiner; however, none of them appear to be pertinent to the claimed invention for the SMA application. I note that sheet number and nature of the references cited by the Examiner seem to contradict his first rejections on the ground of lack of utility.

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7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: 2/11/03

Russell E. Parks

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